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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,473	08/07/2003	Alejandro Wiechers	200207445-1	1048

  

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EXAMINER	
DANNEMAN, PAUL	

  

ART UNIT	PAPER NUMBER
3627	

  

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/635,473

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

Paul Danneman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7 August 2003</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Status of Claims

1. This action is in response to the application filed on 7 August 2003.
2. Claims 1-17 have been examined.

### Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- 1, 2, 7, 9, 10, 15, 17*
5. **Claims 1-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. US 5,963,968 henceforth known as Warmus.

6. **Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully

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the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 9, and 17:**

With regard to the limitations:

- ***Creating a production ready file at designer location using print service provider device configuration.***
- ***Production ready file includes shipping instructions.***
- ***Submitting production ready file to print service provider via an electronic network.***
- ***Receiving a printed out of the production ready file and shipping in accordance with shipping instructions.***

Warmus in at least Column 5, lines 3-8 discloses a demand printer and printer control system, which may be located locally or remotely. Warmus in at least Column 5, lines 9-24 further discloses the use of master and variable page files and a press command file which are stored in memory and be merged to create a plurality of combined files representing pages to be reproduced; the combined files can be converted to a suitable format and transmitted to a remote location using a facsimile machine, e-mail or other transmission medium to be printed. Warmus in at least Column 5, lines 60-67 and Column 6, lines 1-7 still further discloses further discloses assembling the pages, printing address labels, etc. in preparation for distribution. Warmus in at least Column 4, lines 34-36, Column 6, lines 67 and Column 7, lines 1-5 further discloses the use of postal information for mailing to an addressee. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to conclude that Warmus' invention is similar in function to applicant's invention.

**Claims 2 and 10:**

With regard to the limitation:

- ***Submitting includes a verification step at the print service provider to verify that the production ready file can be printed and if not correcting the file of its deficiencies.***

Warmus does not specifically disclose a verification step to determine if a production ready file can be printed. However, Warmus in at least Column 5, lines 44-59 discloses a control unit for controlling and making ready files and ensuring that if they are sent to remote print devices that they are properly converted before being printed. Warmus in at least Fig.2 further discloses a prepress step, which performs the standard printer's file verification prior to printing. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Warmus provides the necessary verification to insure a quality product.

**Claims 7 and 15:**

With regard to the limitation:

- ***Updating a job ticket corresponding to a production ready file.***

Warmus does not disclose the updating of a job ticket based on the state of a production ready file per se. However, Warmus in at least Fig.3, Column 5, lines 60-67 and Column 6, lines 1-7 discloses a finishing apparatus which includes various auxiliary production devices and other control interfaces and devices for preparing a printed item for distribution and detecting a bad printed item and reordering a replacement. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Warmus has the capability to detect and report the status of a printed item in a manner similar to applicant's invention.

7. **Claims 3-6, 8, 16, and 11-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al. US 5,963,968 henceforth known as Warmus as applied to claims 1-2 and 9-10 above, and further in view of FedEx.

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**Claims 3-6, 8, 16, and 11-14:**

With regard to the limitations:

- ***Step of correcting includes reading shipping instructions.***
- ***Providing shipping instructions useable by the printer.***
- ***Selecting a shipper based on shipping instructions.***

Warmus does not specifically disclose reading the shipping instructions from the submitted file. However, Warmus in at least Fig.2 and Column 4, lines 34-36 discloses that printed product is distributed via one or more distribution systems, for example, the U.S. Postal Service. Warmus in at least Column 9, lines 64-67 and Column 10, lines 1-8 discloses a sample database system showing some of the shipping related information, which is collected and used to assist in the shipping process. Therefore, it would be obvious, at the time of the invention, to a person of ordinary skill in the art to determine that Warmus provides a method for insuring product is shipped and is functionally equivalent to applicant's invention.

With regard to the following limitation:

- ***Notification that an order has shipped.***

FedEx in at least FedExTrack a package tracking service using Email, and via FedEx InSight offers tracking without a reference number with proactive notifications by account number. Therefore, it would be obvious, at the time of invention, to a person of ordinary skill in the art to determine that FedEx and other shippers provide shipping and shipping related notification services for use by business entities and individuals. Furthermore, it would be obvious to modify Warmus print service with FedEx's shipping service as a means for insuring that a client receives timely information on the status of their order.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gonzalez et al., US 7,225,220 B2 teaches an on-line selection of print on demand service providers.
- Chiarabini et al., US Pub 2002/0026379 A1 teaches an automated on-line printing service.
- Chou, US 7,127,677 B2 teaches a customizable remote order entry system for print on demand services.
- Sands, US Pub 2001/0027419 A1 teaches fulfilling electronic book orders on demand.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Danneman whose telephone number is 571-270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Danneman  
Patent Examiner



GAU 3627

11 October 2007

 10/13/07  
F. RYAN ZEENDER  
SUPERVISORY PATENT EXAMINER